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09/736,532

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Daniel J. Shoff

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12/29/2004

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EXAMINER

SALCE, JASON P

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,532

Applicant(s)

SHOFF ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. The declaration filed on 7/26/2004 under 37 CFR 1.131 has been considered but is insufficient to overcome the Hidary reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hidary reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The declaration fails to disclose multiple display layouts as claimed by the current amendment filed 7/26/2004.

2. Applicant's arguments filed 7/26/2004 have been fully considered but they are not persuasive.

In regards to the arguments made by applicant, regarding the 102 rejection in view of Dougherty, applicant argues that Dougherty fails to teach, "**multiple different display layouts ... that are selectively displayable in response to a viewer selection**" nor "**dynamically changing the display layouts of the supplemental hyperlink content and the video content program in response to the viewer selection**". The examiner disagrees and notes Column 5, Lines 55-58 for the user selecting a new form to display, therefore multiple display layouts exist for each user

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option in the graphical user interface disclosed in claim 1. The examiner further notes Figure 1 and Column 5, Lines 55-58 for the user making a selection and displaying a new form in the graphical user interface. Note that if a new form is displayed according to the definitions, commands, scripts and data used to display the graphical user interface (see Column 6, Lines 1-8), the note only is the supplemental hyperlink content dynamically changed according to the definitions, commands, scripts and data, but so is the video content, because a new portion of a graphical user interface is defined, which therefore effects the video content portion.

Applicant also argues that Dougherty does not teach, "**encoding the digital data with instructions to dynamically change the display layout of the supplemental content and the video content program in response to viewer control**". The examiner disagrees and notes that the definitions, commands, scripts and data which are used to produce a graphical user interface (see Column 6, Lines 1-8) teaches the data which is encoded (into the VBI at Column 7, Lines 23-51) to provided the functionality to dynamically change the display layout (see Column 5, Lines 55-58).

Applicant also argues that Dougherty does not teach, "**a computer readable storage medium**". The examiner disagrees and notes Figure 2B for a computer readable storage medium used to store the definitions, commands, scripts and data which are used to produce a graphical user interface (see Column 6, Lines 1-8) extracted from data extractor 218 and stored in storage device 224 (see Column 9, Lines 27-42).

Therefore, the 102 rejection in view of Dougherty stands.

In regards to the arguments made by applicant, regarding the combination of Dougherty and Throckmorton, applicant argues that Dougherty teaches away from the use of two separate signals. The examiner believes that applicant has made a valid argument for Dougherty teaching away from Throckmorton, but feels that because of the broad claim limitations that an alternative view can be taken with the two combined references, specifically, in relation to the transmission of the digital data and video content program and where the data is coming from (the video content program and digital data sources). The first limitation regarding the transmission resides in claim 60, which states, "transmitting the digital data along with the video content program as two separate signals". The limitation is broad, and Dougherty in fact, teaches the transmission in two separate signals. The first signal is the signal carrying the video program (at a higher frequency), which is separate from the second signal being the signal carrying the digital data (VBI at a lower frequency). Note that the use of the limitation "separate signals" is broad. When broadcasting video to a viewer through a set-top box, each channel contains it's own frequency, and uses a separate frequency to carry digital data (in the VBI portion). See Column 7, Lines 25-33 for Dougherty supporting this method of transmission.

Throckmorton also discloses the use of the VBI for transmission of digital data (see Column 5, Lines 56-59), but further teaches that the first and second signals are transmitted from different sources (see Column 4, Lines 1-6 for creating a combined signal with primary (video content) and associated (digital) data from different sources and Column 5, Lines 56-59 for the associated data being inserted into the VBI. Also

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note Column 4, Lines 34-51 for how the separate signals are transmitted from primary content generator 10 and associated content generator 16. Note that claim 60 and 61 are broad and do not specify, which part of the system is receiving the transmitted signals. Note both the signals are separate and transmitted from two separate sources (see Column 4, Lines 34-51 of Throckmorton in regards to claim 61) and are also transmitted as two separate signals (in the video content portion, which is transmitted at a different frequency than the digital data transmitted in the VBI frequency). The examiner has re-written the rejection in regards to Dougherty in view of Throckmorton.

Applicant does not argue the grounds of rejection in regards to Hidary. Since the affidavit under 37 C.F.R. 1.131 is insufficient, the rejection in regards to the Hidary reference stands. The examiner notes that Hidary still reads on claims 56-69, and is addressed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 56-59 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hidary et al. (U.S. Patent No. 5,778,181).

Referring to claim 56, Hidary discloses configuring digital data (URL transmitted in the VBI at Column 3, Lines 55-58) which defines a display layout prescribing how the supplemental hyperlink content (Web pages) and the video content program video programming) are to appear in relation to one another when displayed (see Column 5, Lines 7-12 and Column 6, Lines 1-9).

Hidary also discloses that the digital data (Web Pages) are selectively displayable in response to a viewer selection (see Column 5, Lines 52-55 for providing the user with the option to selection a web page for display).

Hidary also discloses transmitting the digital data and the video content program to a viewer-computing unit (see Column 4, Lines 12-17 and Local PC 16 in Figure 2).

Hidary also discloses displaying the supplemental hyperlink content and the video content program according to the display layout (see Column 6, Lines 9-11).

Hidary also discloses dynamically changing the display layouts of the supplemental hyperlink content and the video content program in response to said viewer's selections (see Column 5, Lines 48-55). Note that each time a viewer selects a different web page, different information is displayed (see Column 6, Lines 4-24 for displaying different types of web pages), and therefore the display layout is dynamically changed in response to a viewer selection. Also note that the display layout can be dynamically changed in response to the program the viewer is watching (see Column 6, Lines 4-24).

Referring to claim 57, Hidary discloses configuring the data to define multiple different display layouts that are selectively displayed to the viewer depending upon the

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viewer's selections of possible choices presented in the supplemental hyperlink content (see Column 5, Lines 16-19).

Hidary discloses dynamically changing the display layouts of the supplemental hyperlink content and the video content program in response to said viewer's selections (see Column 5, Lines 48-55). Note that each time a viewer selects a different web page, different information is displayed (see Column 6, Lines 4-24 for displaying different types of web pages), and therefore the display layout is dynamically changed in response to a viewer selection. Also note that the display layout can be dynamically changed in response to the program the viewer is watching (see Column 6, Lines 4-24).

Referring to claim 58, Hidary discloses transmitting the digital data along with the video content program as the same signal (see Column 3, Lines 46-50 and Lines 55-58).

Referring to claim 59, Hidary discloses receiving said signal containing the digital data and the video content program at the viewer-computing unit (see Column 4, Lines 37-40).

Hidary also discloses separating the digital data from the video content program at the viewer-computing unit (see Column 4, Lines 40-43).

Referring to claims 66-67, see rejection of claims 56-57, respectively.

4. Claims 56-60 and 66-68 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dougherty et al. (U.S. Patent No. 5,848,352).

Referring to claim 56, Dougherty discloses configuring digital data, which defines a display layout prescribing how the supplemental hyperlink content and the video

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content are to appear in relation to one another when displayed (see Figures 7A and 7B and Column 14, Lines 15-37 for the Object Definitions describing how the content is displayed in relation to the video and Column 7, Lines 5-10 for the creation of such data).

Dougherty also discloses transmitting the digital data and the video content program to a viewer-computing unit (see Column 7, Lines 23-32).

Dougherty also discloses displaying the supplemental hyperlink content and the video content program according to the display layout (see Figure 1).

Referring to claim 57, Dougherty discloses configuring the data to define multiple different display layouts that are selectively displayed to the viewer depending upon the viewer's selections of possible choices presented in the supplemental hyperlink content (see Column 19, Lines 19-27 and Lines 40-46).

Dougherty also discloses dynamically changing the display layouts of the supplemental hyperlink content and the video content program in response to said viewer's selections (see Column 21, Lines 11-38 for using scripts to dynamically change the layout).

Referring to claim 58, Dougherty discloses transmitting the digital data along with the video content program as the same signal (see Column 7, Lines 60-62).

Referring to claim 59, Dougherty discloses receiving said signal containing the digital data and the video content program at the viewer-computing unit (see element 234 in Figure 2B and Column 9, Lines 18-19).

Dougherty also discloses separating the digital data from the video content program at the viewer-computing unit (see Column 9, Lines 28-30).

Referring to claim 66, see rejection of claim 56.

Referring to claim 67, see rejection of claim 57.

Referring to claim 68, Dougherty discloses supplemental content for rendering to a viewer, which supplements viewing of a continuous, non-interactive video stream (see Figures 7A, 7B and Figures 8-13).

Dougherty also discloses one or more elements prescribing how the supplemental content is to be rendered along with, and relative to, the video stream (see again Figures 8-13 for objects that are to be displayed with the window displayed along with the video program in Figure 7A).

Referring to claim 60, see the rejection of claim 59, and also note that Dougherty discloses transmitting the digital data in the VBI along with the video content program in a separate signal (frequency), thereby teaching transmission in two separate signals (see Column 7, Lines 25-33 and the arguments made in the "Response to Arguments" section regarding separate transmission using the VBI and regular channel frequencies).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 61-65 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. (U.S. Patent No. 5,848,352) in view of Throckmorton et al. (U.S. Patent No. 5,818,441).

Referring to claim 61, Dougherty discloses all of the limitations in claim 56, as well as the transmission of two separate signals (see the rejection of claim 60 and arguments made in the "Response to Arguments" section), but fails to teach transmitting the video content and digital data as a first and second signal, respectively, from a first and second source, respectively.

Throckmorton discloses transmitting a first and second signal from two separate sources (see Column 4, Lines 34-51).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the transmission medium, as taught by Dougherty, using the two separate sources, as taught by Throckmorton, for the purpose of allowing a consumer to experience apparent interactivity with external data sources (see Column 2, Lines 49-50 of Throckmorton).

Claim 61 corresponds to claim 56, see rejection of claim 60 for transmitting the associated data and primary data on two different transmission mediums (sources).

Referring to claim 62, Dougherty discloses all of the limitations in claim 56, and also teaches creating a document having extension attributes that assist in defining the display layout (see Figures 8-13 of Dougherty), but fails to teach that this document uses the HTML standard. Throckmorton specifically uses HTML syntax to define the layout of the user interface displayed by a user (see Column 3, Lines 62-67). At the

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time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the data layout data transmitted to the client, as taught by Dougherty, by using the HTML layout data, as taught by Throckmorton, for the purpose of lowering the cost of the system by providing a universal standard format that can be understood by all programmers around the world.

Claim 63 directly relates to claim 62, where Dougherty discloses an Interactive Icon Definition used for specifying a focus extension attribute (see Column 20, Lines 60-65).

Referring to claim 64, see rejection of claim 62.

Claim 65 corresponds to claim 64, where Dougherty discloses a tag to retrieve and display one of the images (see Column 21, Lines 11-38 for a script (tag) that can display an image upon actuation by a user).

Referring to claim 69, see rejection of claims 62 and 64.

Conclusion

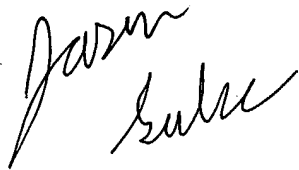
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 22, 2004

A handwritten signature in black ink, appearing to read "Jason" followed by a stylized surname, possibly "Sullivan".